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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,389

12/23/2004

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EXAMINER

WOOD, KIMBERLY T

ART UNIT

PAPER NUMBER

3632

MAIL DATE

DELIVERY MODE

05/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,389

Applicant(s)

PARK, SEUNG BAE

Examiner

Kimberly T. Wood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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This is an office action for serial number 10/519,389, in response to applicant's inquiry into whether the preliminary amendment of December 23, 2004 was considered by the examiner. The examiner did not consider the preliminary amendment of December 23, 2004 and is sorry of inconvenience this may have caused the applicant. The following office action includes the a rejection to the preliminary amendment of December 23, 2004.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims, 7 and 12 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the hinge having a toothed wheel wherein the teeth are on the outside surface of the wheel, does not reasonably provide enablement for the hinge having a toothed wheel in combination with female threads at the inner circumference. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is an inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear. The preamble in claim clearly indicates that a subcombination is being claimed, e.g., "a sunglasses holder, which is suitable for comprising a pair of sunglasses to an item" This language would lead the examiner to believe that the applicant intends to claim only the subcombination of "a sunglasses holder," the item and sunglasses being only functionally recited. This presents no problem as long as the body of the claim also refers to the functionally, such as, "for attachment to said item or sunglasses".

The problem arises when the item is positively recited within the body of the claim, such as, "connection member coupled to the sunglasses." There is an inconsistency within the claim; the preamble indicates subcombination, while in at least one instance in the body of the claim there is a positive

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recital of structure indicating that the combination of a and a are being claimed. The examiner cannot be sure if applicant's intent is to claim merely the sunglasses holder or the sunglasses holder in combination with the cap.

Applicant is required to clarify what the claims are intended to be drawn to, i.e., either the sunglasses holder alone or the combination of the sunglasses holder and the cap or sunglasses. Applicant should make the language of the claim consistent with applicant's intent. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the **subcombination** and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. (e.g. a body having an opening formed at the under face, female thread from at the inner circumference, etc.).

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Claim 4 recites the limitation "the side wall" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the under face" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the side wall" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 and 12 recites the limitation "the inner circumference" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the outer circumference" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "them" in line 2. There is insufficient antecedent basis for this limitation in the claim.

The claims have been rejected under 35 U.S.C. 112 for the above reasons. Please note that the Examiner may not have pointed out each and every example of indefiniteness. The applicant is required to review all the claim language to make sure the claimed invention is clear and definite.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4 , 8, 9, and 14 are rejected, as best understood, under 35 U.S.C. 102(b) as being anticipated by Simone 5,720,040. Simone discloses a fixing member (14), a connection member (22), hinges (16) having a toothed wheel (see figure 8) and a hinge pin (37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 5, 8, 9, 10, 13-15 are rejected, as best understood, under 35 U.S.C. 103(a) as being unpatentable over Ko 1020020066148A in view of Okeke et al. (Okeke) 2001/0023518. Ko

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discloses a fixing member (4); a connection member (upper part of 19 opposite the hinge area) being a body having an opening (near 15), holes (near 16), a resilient piece having a button (18); hinges (19 and 17); the detachably-attaching member (6) having a resilient hook (11); sunglasses (3); and a cap visor (1). Ko discloses all of the limitation of the claimed invention for the fixing member being a body having an opening and a fixing means for fixing the body to the cap and the detachable attaching member being coupled to and the connection member being coupled to the sunglasses. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the fixing member being the body having the opening, a resilient piece having a button projected through the hole with a fixing means being fixable to the cap and the connection member and detachably-attaching member being coupled to the sunglasses, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. Ko discloses all of the limitations of the claimed invention except for the hinges having a toothed wheel and hinge pin. Okeke discloses it is known to have a hinge having a toothed wheel and a hinge pin (Figure 7). It would have been obvious to one having ordinary skill in the art to have modified Ko to have included the

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toothed wheel and pin as taught by Okeke for the purpose of providing somewhat fixed positioning when adjusting the sunglasses relative to the cap therefore preventing accidental repositioning.

Claim 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ko, as discussed above, in view of Okeke et al. (Okeke) 2001/0023518 in view of Kiefer 5,361,455. Ko discloses all of the limitations of the claimed invention except for the fixing member including a bolt, a support plate integrally formed at both sides of the body and having a hole. Kiefer teaches that it is known to have a fixing member including a bolt (88), a support plate (38) integrally formed at both sides of the body (36) and having a hole (66). It would have been obvious to one having ordinary skill in the art to have modified Ko to have included the including a bolt, a support plate integrally formed at both sides of the body and having a hole as taught by Kiefer for the purpose of providing a better means of attaching the fixing member which allows detachment.

Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ko, as discussed above, in view of Okeke et al. (Okeke) 2001/0023518 in furtherer view of Miller et al. (Miller) 5,933,919. Miller discloses all of the limitations of

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the claimed invention except for the female thread at the inner circumference and the pin having a male thread from on the outer circumference. Miller teaches that it is known to have a the female thread at the inner circumference (5-9) and the pin having a male thread from on the outer circumference (10). It would have been obvious to one having ordinary skill in the art to have modified Ko to have included the toothed wheel and pin as taught by Miller for the purpose of providing somewhat fixed positioning when adjusting the sunglasses relative to the cap therefore preventing accidental repositioning.

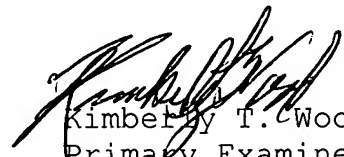
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Wood whose telephone number is 571-272-6826. The examiner can normally be reached on Monday-Thursday 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kimberly T. Wood
Primary Examiner
Art Unit 3632

May 28, 2007